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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/917,134

07/27/2001

Jerry Pavelka

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33448

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05/30/2007

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

05/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/917,134

Applicant(s)

PAVELKA, JERRY

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is responsive to the RCE filed 03/09/2007 to the application filed 07/27/2001.

Claims 1-5, 7-12, and 14 are presented for examination. Claim 15 has been canceled.

Claims 1 and 8 are independent claims.

Please note that examiner formerly in charge of examining this application, Paul H. Nguyen, is no longer employed at the USPTO. Now Maikhanh Nguyen is in charge of examining this application. Please update future correspondence accordingly.

### **Request Continuation for Examination**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/09/2007 has been entered.

### Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

Claims 1-5, 7-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over “*Solving Print Production Problems with Acrobat InProduction*”, White Paper, Adobe Systems Inc., at least prior to April 2, 2001 (via HotBot Advance Search Engine) (Hereinafter “**InProduction**”) in view of **Laverty et al.** (US 6771384, filed 01/10/2000).

#### As to claims 1 and 8:

InProduction teaches a computer implemented method and a system for entering advertising registration marks into an image (*see page 1*) comprising:

- generating specification data for a plurality of advertising registration marks (*see pg. 6, 1<sup>st</sup> full ¶ - pg. 7, 3<sup>rd</sup> ¶*);
- inserting a plurality of advertising registration marks into an image by a user at locations determined by the specification data (*see pg. 6, 1<sup>st</sup> full ¶ - pg. 7, 3<sup>rd</sup> ¶*); and
- displaying the image (*e.g., image is displayed; pg. 6*).

InProduction, however, does not specifically teach wherein a user generates specification data by accessing a digital data storage device containing information providing a correlation between a publication designation and a plurality of dimensional specifications for advertising registration marks that are associated with the user designated publication, wherein the digital data storage device stores information providing the correlation between the publication and the plurality of dimensional specifications and further wherein one or more persons or entities other than the user stores the information in the digital data storage device providing the correlation between the publication and the dimensional specifications.

Laverty teaches wherein a user generates specification data by accessing a digital data storage device containing information providing a correlation between a publication designation and a plurality of dimensional specifications for advertising registration marks that are associated with the user designated publication, wherein the digital data storage device stores information providing the correlation between the publication and the plurality of dimensional specifications and further wherein one or more persons or entities other than the user stores the information in the digital data storage device providing the correlation between the publication and the dimensional specifications.

*(col. 8, lines 43-62; and col. 22, line 35-col. 23, line 47).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify InProduction with Lavery because it would have provided a tightly integrated professional toolset that works within the familiar Acrobat interface and enables a user to manage, manipulate, and process PDF files through a color print production workflow.

**As to claims 2 and 9:**

InProduction teaches the advertising registration marks is a trim mark (*see pg. 6, 1<sup>st</sup> full ¶ - pg. 7, 3<sup>rd</sup> ¶*).

**As to claims 3 and 10:**

InProduction teaches the advertising registration marks is a bleed mark (*see pg. 6, 1<sup>st</sup> full ¶ - pg. 7, 3<sup>rd</sup> ¶*).

**As to claim 4:**

InProduction teaches the advertising registration marks is a live mark (*see pg. 6, 1<sup>st</sup> full ¶ - pg. 7, 3<sup>rd</sup> ¶*).

**As to claims 5 and 12:**

InProduction teaches the advertising registration marks is a gutter mark (*see pg. 6, 1<sup>st</sup> full ¶ - pg. 7, 3<sup>rd</sup> ¶*).

**As to claims 7 and 14:**

InProduction teaches scaling a relative size of at least one registration mark with respect to the image information (*see Trim/Bleed section; pg.6*).

**Response to Arguments**

4. Applicants' arguments filed 03/09/2007 have been considered but they are not persuasive.

Applicant's arguments are substantially directed to the amended subject matter. The amended subject matter is addressed above with respect to the discussion of independent claims 1 and 8.

**Conclusion**

5. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

**Contact information**


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**  
Commissioner for patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

MN

  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**